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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,630	10/11/2001	Robert E. Haines	10007585-1	1660

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

AIRES, BENJAMIN A

ART UNIT	PAPER NUMBER
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2142

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/976,630	Applicant(s) HAINES, ROBERT E.	
	Examiner Benjamin A. Ailes	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to correspondence filed 13 December 2006.
2. Claims 1-39 remain pending. Claims 37-39 have been withdrawn from consideration.
3. In view of the Appeal Brief filed on 13 December 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection have been set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21-27 are not limited to tangible embodiments. Regarding claim 21, the claim recites "A computer instruction signal embodied in a carrier wave carrying instructions...". A carrier wave is not deemed a tangible computer readable medium. As such, the claim is not limited to statutory subject matter and is therefore non-statutory. Dependent claims 22-27 are rejected under the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama (US 6,333,790 B1) in view of Engel et al. (US 2002/0198969 A1), hereinafter referred to as Engel.

8. Regarding claims 1, 8, 15, 21 and 31, Kageyama teaches the downloading of configuration information in the form of program updates for a printer device (col. 15, ll. 33-39) but does not explicitly teach the utilization of a configuration plug-in. However, in related art, Engel teaches on the use of the configuration of network devices utilizing an applet (page 1, paragraph 0008), which is deemed functionally equivalent to the software plug-in claimed. One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize a plug-in to perform a step of retrieving

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information on a network. One of ordinary skill in the art would have been motivated to combine teachings of Engel with Kageyama as taught by Engel wherein the use of an applet reduces cost of device configuration (page 1, paragraph 0007). Kageyama teaches the installation of downloaded information to configure printer devices (col. 16, ll. 36-41).

9. Regarding claims 2, 9, 16 and 22, Kageyama and Engel teach the method wherein the configuration plug-in and configuration data include data prepared by:

determining a make and model for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information); and

determining user thresholds for consumables associated with the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; use information).

10. Regarding claim 3, Kageyama and Engel teach the method wherein downloading includes:

sending an electronic message via the Internet to a website for a vendor associated with the hard copy output engine (Kageyama, col. 11, ll. 48-59); and

receiving an electronic message via the Internet in response to sending (Kageyama, col. 11, ll. 48-59).

11. Regarding claims 5, 12, 17, and 25, Kageyama and Engel teach the method wherein configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (Kageyama, col. 6, ll. 5-11).

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12. Regarding claims 6, 13, 19, and 26, Kageyama and Engel teach the method wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (Kageyama, col. 5, ll. 58-61).

13. Regarding claims 7, 14, 20, and 27, Kageyama and Engel teach the method wherein the configuration plug-in and configuration data include data prepared by:

determining a make and model for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information);

determining a serial number for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information); and

determining user thresholds for consumables associated with the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; use information).

14. Regarding claim 28, Kageyama and Engel teach the method wherein the downloading comprising downloading a value, and the configuring comprises setting a threshold for a consumable associated with the hard copy output engine using the value (Kageyama, col. 16, ll. 36-41).

15. Regarding claims 29 and 34, Kageyama and Engel teach the method wherein the downloading comprising downloading a threshold for replenishment of a consumable associated with the hard copy output engine (Kageyama, col. 16, ll. 36-41).

16. Regarding claim 30, Kageyama and Engel teach the method wherein the configuring comprises setting the threshold of the hard copy output engine (Kageyama, col. 16, ll. 36-41).

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17. Regarding claims 32 and 35, Kageyama and Engel teach the method wherein the configuring comprises altering the hard copy output engine (Kageyama, col. 16, ll. 36-41).

18. Regarding claims 33 and 36, Kageyama and Engel teach the method wherein the configuring comprises altering an operation of the hard copy output engine with respect to formation of hard images upon paper (Kageyama, col. 16, ll. 36-41).

19. Claims 4, 10, 11, 18, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama and Engel in view of Uchida et al. (U.S. 6,317,570), hereinafter referred to as Uchida et al.

20. Regarding claims 4, 10, 11, 18, 23, and 24, Kageyama and Engel taught the method of sending and receiving electronic message transmissions (Kageyama, col. 11, ll. 48-59) via the Internet and Internet access provided by Internet service providers, but are silent on the use of a firewall. However in related prior art, Uchida et al. disclose a method for a user and a service center for the peripherals to establish communication via the Internet and have it secured by use of a firewall (see Fig. 1, Fig. 2, col. 3, lines 3-35). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize the use of a firewall as disclosed in the method of communication utilized by Uchida et al. in order to achieve the desired level of security and protection a firewall offers (Uchida et al., col. 3, lines 3-4 and 30-32). It is for this that one of ordinary skill in the art would have been motivated to modify and improve the communication method taught by Kageyama and Engel to represent the more secure communication via the Internet method disclosed by Uchida et al.

Response to Arguments

21. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ohtani (US 6,108,099) teaches an image forming apparatus and management system therefor.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes whose telephone number is (571)272-3899. The examiner can normally be reached on M-F 6:30-4, IFP Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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